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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,239	02/19/2004	Jean-Louis Guyot	C-CPI-0114	1428

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EXAMINER

VAN, LUAN V

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/783,239

Applicant(s)

GUYOT, JEAN-LOUIS

Examiner

Luan V. Van

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's amendment of July 17, 2006 does not render the application allowable.

Status of Objections and Rejections

The rejection of claim 3 is obviated by Applicant's cancellation.

All rejections from the previous office action are maintained.

New grounds of rejection under 35 U.S.C. 103(a) are necessitated by the amendments.

Election/Restrictions

Applicant's election of claims 1-8 in the reply filed on July 17, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1753

Claims 4, 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 4, the new limitation of "and said area has a length that is a plurality of times said area length" is unclear. An area is a two-dimensional space; it is unclear how an area can have a one dimensional length. It is also unclear what an area length is. Similarly, regarding claim 8, the new limitation of "and said opening has a length that is a plurality of times greater than a length of said opening" is unclear.

Regarding claim 6, the limitation of "tiny" is a relative terminology; it is unclear how tiny is tiny.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Sewell et al.

Regarding claims 1 and 6, Sewell et al. teach an apparatus and a method for depositing an electrically conductive layer of precious metal (column 1 lines 11-16) on a face of a metal substrate 1 (figure 1) by maintaining a mask 15, 16 closely over the substrate face while the face and mask are immersed in an electrolyte and the precious

Art Unit: 1753

metal is electrodeposited through the electrolyte onto the substrate face, comprising: maintaining a screen 7 closely between said mask and said substrate face, said screen having a regular pattern of through holes (column 5 lines 25-29), and including flowing the electrolyte into said through hole and against the substrate face (column 8 lines 29-50), and electrodepositing the precious metal through the electrolyte lying in said holes onto the substrate face. The mask 7 of Sewell et al. is broadly interpreted to read on the screen of the instant claim, since it contains a regular pattern of through holes. The mask 7 of Sewell et al. is made of a nonconductive material (column 5 lines 7-9). All parts of the layer that lie within the electroplated area are electrically connected together. Regarding claim 6, the holes of mask 7 is smaller than the opening of mask 15, 16, and the holes lie in line with the mask 15, 16 opening.

Regarding claim 5, Sewell et al. teach the mask is of elastomeric material (column 3 lines 65-68), and including compressing said screen between said mask and said substrate face, and maintaining locations on said screen that lie in openings of said mask against said substrate face (column 9 lines 29-34).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1753

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 4 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sewell et al. in view of Topelian.

Sewell et al. teach the method and apparatus as described above. Sewell et al. differ from the instant claims in that the reference teach a screen but does not explicitly disclose the screen is formed of multiple wires that have a rounded periphery (claim 2) nor the screen is woven from of threads of rounded cross-section (claims 4 and 7-8).

It is conventionally known in the art to use a woven screen in an electroplating process. For example, Topelian teaches an electroplating process for electroplating articles of irregular shape or articles having multi-planar areas using a deformable woven wire mesh fabric or screen (column 1 lines 70 -- column 2 lines 16).

Addressing claims 2, 4 and 7-8, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the method and apparatus of Sewell et al. by using the woven wire mesh of Topelian, because it would allow the metal deposited to conform to the shape of the substrate. With respect to claims 4 and 8, changing the size of the openings would have been an obvious

Art Unit: 1753

modification within the ability of one having ordinary skill in the art, since the "mere scaling up of the prior art process capable of being scaled up... was not established patentability into claim to an old process so scaled" (MPEP 2144.04).

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

In the arguments presented on page 5 of the amendment, the applicant argues that Sewell et al. do not teach the screen between the mask and a substrate. The examiner respectfully disagrees. As described above, the mask 7 of Sewell et al. is broadly interpreted to read on the screen of the instant claim, since it contains a regular pattern of through holes. The mask 7 of Sewell et al. is made of a nonconductive material (column 5 lines 7-9). All parts of the layer that lie within the electroplated area are electrically connected together.

With respect to the argument that Sewell et al. would not produced a pattern of peaks and valleys of the instant invention, the applicant is arguing a limitation which is not in the claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant further argues that Topelian does not use a nonconductive material. The examiner acknowledges that a conductive screen is used in the preferred embodiment of Topelian. However, Topelian teach that using nonconductive masks is conventionally known (column 1 lines 54-59). Moreover, as the applicant is aware, a

Art Unit: 1753

reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989). See also *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). See MPEP 2123. Furthermore, Sewell et al. already teaches using a nonconductive screen 7.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1753

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan V. Van whose telephone number is 571-272-8521.

The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on 571-272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LVV
July 28, 2006


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